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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,546	10/07/2003	Alan E. Stein	ITW7510.074	2545
33647	7590	07/19/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ITW) 14135 NORTH CEDARBURG ROAD MEQUON, WI 53097				KERNs, KEVIN P
ART UNIT		PAPER NUMBER		
1725				

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/605,546	STEIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Kevin P. Kerns	1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 October 2003 and 16 May 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Specification***

1. The disclosure is objected to because of the following informalities: in amended paragraph [0030], 12<sup>th</sup> line, replace "32" with "36" after "work piece". Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-43 of copending Application No. 10/604,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims include at least the following common features: a welding torch configured to present an electrode to a weld; an enclosure (welder housing); a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout

disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value; a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system. One of ordinary skill in the art would have recognized that the additional features present for the welding-type system of copending Application No. 10/604,459 would selectively be present on the welder of the present application, as open-ended "comprising" language is present in the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to amended independent claim 12, the claim is awkward and unclear as written with regard to what the limitations "monitor a temperature of the coolant" and

"continue to circulate coolant" are modifying (last 5 lines of the claim appear to require punctuation for clarity). In this instance, it is believed that the applicants should add the following to clearly define the claim: "a)" before "regulate", "b)" before "monitor", and "c)" before "continue".

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-23 are rejected (see complete translation of the French text) under 35 U.S.C. 102(b) as being anticipated by Prunier (FR 2 536 320).

Prunier discloses an arc welding machine that includes a refrigeration unit for torch cooling, in which the welding machine further includes a welding torch configured to present an electrode to a weld; an enclosure (welder housing) with a base plate, side plates, end plates, and a top cover; a power conditioner (power source/supply) disposed within the enclosure; a cooling system having a coolant tank and a spout disposed within the enclosure to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the

weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value (i.e. threshold, predetermined value, and/or certain set point after deactivation of the welding machine); a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system (abstract; translation of French text of specification and claims; and Figure).

8. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Behnke et al. (US 2,510,207).

Behnke et al. disclose a fluid control system for inert gas blanketed arc welding, in which the welding machine further includes a welding torch T with a cooling jacket J configured to present an electrode E to a workpiece to be welded W; a power conditioner (power source/supply); a cooling system having a coolant tank (manifold) and a spout operable to circulate coolant through the welding torch/component via coolant hoses (providing supply and return paths for the coolant); a controller operable to control the cooling system and power conditioner; a means to automatically commence coolant circulation through the torch when the electrode is presented to the weld; a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value (i.e. threshold, predetermined value, and/or certain set point after deactivation of the welding machine); a heat exchanger and water pump assembly; and at least one check valve integrated with the cooling system (column 1, line 1 through column 3, line 61; and Figure).

***Response to Arguments***

9. The examiner acknowledges the applicants' amendment and replacement drawing sheet received by the USPTO on May 16, 2005. The amendments and replacement drawing sheet overcome prior objections to the drawings, abstract, specification, and claims. A minor specification objection remains (see paragraph 1). Provisional double patenting rejections remain (see paragraph 3). A new rejection under 35 USC 112, 2<sup>nd</sup> paragraph has been raised by the amendment (see paragraph 5). The applicants are reminded of 5 foreign documents not provided/considered in the IDS of December 13, 2004. Claims 1-23 remain under consideration in the application.

10. Applicants' arguments filed May 16, 2005 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 9-11 of the response, the applicants are referred to paragraph 9 of the prior Office Action (paragraph 7 in this Office Action) to show that the 35 USC 102(b) rejections based on Prunier (FR 2 536 320) was not a result of reliance solely upon the abstract. The "French text of specification and claims; and Figure" are also cited at the end of the paragraph. It is noted that a complete translation of a foreign document can take up to several weeks to obtain (in this instance about 4 weeks from the Office Action writing date of March 19, 2005 and mailing date of March 22, 2005 -- with the examiner's request for translation date being March 21, 2005). In the future, it is kindly requested that the applicants employ their resources to obtain a complete translation of pertinent foreign documents

upon receipt of first and/or subsequent Office Actions to enable a complete reply and hasten prosecution history. However, a complete translation of the French document (which was finally obtained on April 20, 2005) is enclosed with this Office Action. In contrast to the applicants' remarks at the bottom of page 9, the French document includes "dynamically controlling coolant flow" – see translation of French text and the newly underlined portion of paragraph 7. Regarding the Behnke et al. reference, the applicants are kindly referred to the newly underlined portion of paragraph 8. Furthermore, column 1, lines 24-27 of Behnke et al. (as discussed on page 10, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs of the remarks) discloses and/or implies that a "threshold", "predetermined value", and/or "certain set point" have been obtained to enable "cutting off the flow of cooling water". In other words, if the electrode in the Behnke et al. invention is above "oxidation temperature", then coolant would continue to flow until it is below the "oxidation temperature". As a result, all of independent claims 1, 12, 18, and 23 (and claims dependent therefrom) do not patentably distinguish over Behnke et al.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 7/17/05*  
Primary Examiner  
Art Unit 1725

KPK  
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July 17, 2005